UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,200	06/08/2000	Simon G. Thompson	36-1494	9948

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EXAMINER
NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
2124	8

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/589,200	Applicant(s) THOMPSON ET AL.
	Examiner Qamrun Nahar	Art Unit 2124

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 April 2003_ .

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-10_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-10_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This action is in response to the amendment filed on 4/21/03.

2.   The objection to the drawings is withdrawn in view of applicant's remarks.

3.   The objections to the disclosure are withdrawn in view of applicant's remarks.

4.   Claims 1-10 are pending.

5.   Claims 1-10 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Ernst

(U.S. 5,890,133).

Priority

6.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers

have been placed of record in the file.

Response to Amendment

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.   Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst (U.S.

5,890,133).

Per Claim 1:

The Ernst patent discloses:

- a method of generating a process plan ("a method and a device for the dynamic optimization of business processes" in abstract)

- storing at least one generic process plan ("The stored information is the starting basis for the optimization of the business processes" in column 3, lines 43-44, the starting basis is interpreted as a generic process plan)

- storing at least one non-generic process element containing a predetermined pattern ("The collection of the parameters must be first defined; the selection of parameters is typically ruled by predetermined business targets ... processing data is collected and stored" in column 3, lines 15-20 and Fig. 1, items 102 and 104, the collection of the parameters are interpreted as non-generic process elements which are ruled by predetermined business targets/pattern)

- searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element ("Identification of a business process instance with propitious result data is carried out with a view of selecting favorable level settings of the business process instance. Level settings indicate the various implementations of the parameters of a business process instance" in column 3, lines 28-33 and Fig. 1, items 101-105, identification of a business process instance is done by searching the starting basis and selecting the collection of parameters which are ruled by predetermined business targets/pattern)

- on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan ("the real occurring processes enter their parameters directly into the starting basis" in column 3, lines 50-52 and Fig. 1, items 105-108)

- outputting the generated process plan ("each completed business process instance enters its parameters, processing and result data into the starting basis ... updated with actual data" in column 4, lines 10-15).

Per Claim 2:

The Ernst patent discloses:

- the steps of receiving for storage at least one generic process plan and receiving for storage at least one non-generic process element (column 3, lines 15-20 and lines 43-44, storage is inherent).

Per Claim 3:

The Ernst patent discloses:

- each stored generic process plan is indexed in accordance with a goal to be achieved by the plan (column 8, lines 34-38)

- **receiving a goal input** (column 7, lines 66-67 to column 8, lines 1-6)

- **selecting a generic process plan for searching, said selection being in accordance with the received goal input** (column 8, lines 7-11).

Per Claim 4:

The Ernst patent discloses:

- **at least one non-generic process element comprises resource information** (column 6, lines 46-50)

- **identifying one or more resources to support a process step in a generated process plan** (column 6, lines 46-50 and Fig. 1, item 103).

Per Claim 5:

The Ernst patent discloses:

- **each stored non-generic process element comprising resource information is indexed in accordance with one or more relevant resources** (column 6, lines 46-53).

Per Claim 6:

The Ernst patent discloses:

- at least one inserted process element comprises data (column 4, lines 10-15).

Per Claim 7:

The Ernst patent discloses:

- at least one non-generic process element comprises context specific method data (column 6, lines 46-50)

- indexed for storage according to the relevant context (column 6, lines 46-53).

Per Claim 8:

The Ernst patent discloses:

- the context for at least one non-generic process element is service type (column 7, lines 51-56).

Per Claim 9:

The Ernst patent discloses:

- the context for at least one non-generic process element is customer type (column 8, line 1).

Per Claim 10:

This is an apparatus version of the claimed method discussed above, claim 1, wherein all

claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also anticipated by Ernst.

Response to Arguments

9.   Applicant's arguments with respect to claims 1-10 have been fully considered but they are

not persuasive.

In the remarks, the applicant argues that:

a)   Applicant submits that this portion (and all other portions) of Ernst fails to disclose the

above claimed element. In particular, Applicant fails to see how this portion of Ernst teaches

conducting a **search of a generic process plan**, let alone **searching** the generic process plan for

a predetermined pattern contained in a non-generic process element and inserting content from

the non-generic process element upon detection of the predetermined pattern.

Examiner's response:

a)   Examiner strongly disagrees with applicant's assertion that Ernst fails to disclose the

claimed limitations recited in claims 1-10. Ernst shows each and every limitation in claims 1-10.

As previously pointed out in Paper no. 5, Ernst teaches searching said at least one generic

process plan for the predetermined pattern contained by at least one non-generic process element

(column 3, lines 28-33 and Fig. 1, items 101-105, identification of a business process instance is

done by searching the starting basis and selecting the collection of parameters which are ruled by

predetermined business targets/pattern); on detection of the predetermined pattern, inserting

content from said at least one non-generic process element into the generic process plan to

generate a process plan (column 3, lines 50-52 and Fig. 1, items 105-108). In addition, see the

rejection above in paragraph 8 for rejection to claims 1-10.

In the remarks, the applicant argues that:

b)   The present invention relates to storing one generic process plan ... This distinction

between providing a generic process plan and non-generic process elements which may be used

to customize the generic process plan to generate a customized (newly generated) process plan is

neither disclosed or suggested anywhere in Ernst. In particular, the optimization of process

parameters in a fixed process as disclosed by Ernst fails to disclose the customization of a

generic process plan by insertion of non-generic process elements to effectively generate a new

process plan as required by the claimed invention.

Examiner's response:

b)   Examiner strongly disagrees with applicant's assertion that Ernst fails to disclose the

claimed limitations recited in claims 1-10. Ernst shows each and every limitation in claims 1-10.

As previously pointed out in Paper no. 5, Ernst teaches on detection of the predetermined pattern,

inserting content from said at least one non-generic process element into the generic process plan

to generate a process plan (column 3, lines 50-52 and Fig. 1, items 105-108). In addition, see the

rejection above in paragraph 8 for rejection to claims 1-10.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

11.   Any inquiry concerning this communication from the examiner should be directed to

Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be

reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be

reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the

organization where this application or processing is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

QN
July 1, 2003

Todd Ingberg
Primary Examiner
Group 2100